

Docket No.: 3673-0174PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takahiro SAJIMA et al.

Allowed: December 15, 2004

Application No.: 10/829,341

Confirmation No.: 6808

Filed: April 22, 2004

Art Unit: 3711

For: GOLF BALL

Examiner: R. Gordon

PETITION FROM REFUSAL TO ADMIT AMENDMENT UNDER 37 CFR 1.127

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition under 37 CFR 1.127 and 1.181 from the refusal by the Patent Examiner to admit an Amendment submitted under 37 CFR 1.132 in connection with the above-identified application.

Factual Basis for Petition

The basis for this Petition is the Response to Rule 312 Communication dated November 23, 2005 (copy enclosed) which the Patent Examiner issued in connection with this application. The Response indicated that the Amendment under 37 CFR 1.132 filed February 28, 2005 was “disapproved”, because, “Applicant is not allowed to further prosecution by adding claims after a notice of allowance.”

A review of the Amendment filed February 28, 2005 (not enclosed but available on PAIR) shows that the Amendment submitted with the original, allowed claims 1-3, new

dependent claims 4-10 all depending from original, allowed claim 1. Page 5 of the Amendment indicates the clear support for the new dependent claims 4-10.

In addition to the above, it is noted that the Notice of Allowance which issued in connection with this application on December 15, 2004 was the first Office Action to issue in connection with the present application.

Points to Be Reviewed

It is requested that the refusal of the Patent Examiner to enter the Amendment filed February 28, 2005 be reviewed in view of the reasons stated below.

Reasons that Refusal of Entry of Amendment Was Incorrect

A review of the policies stated in the Manual of Patent Examining Procedure (MPEP) establishes that the action taken by the Examiner and the reasons in support of this action were both incorrect.

MPEP 714.16 states that an amendment submitted after the Notice of Allowance under 37 CFR 1.312 is “.... not to be used for continued prosecution.” However, a closer review of what is meant by “continued prosecution” reveals that the Amendment of February 28th filed in connection of the present application was **not** submitted for the purposed of “continued prosecution”. MPEP 714.16 states that inappropriate “continued prosecution” occurs when: (A) an additional search is required; (B) more than a cursory review of the record is necessary; or (C) the amendment would involve materially added work on the part of the USPTO, such as checking excessive editorial changes in the specification or claims. MPEP 714.16 further states that, “Where claims added by amendment under 37 CFR 1.312 are **all of the form of dependent claims, some of the usual reasons for nonentry are less likely to apply** although questions new matter, sufficiency of disclosure, or undue multiplicity of claims could arise [emphasis added].”

None of the above-noted examples (A), (B), or (C) of “continued prosecution” occurred in the present situation. No additional search is required under example (A), since dependent claims 4-10 all depend from allowed claim 1 and therefore have already been “searched” after completion of the search of claim 1. There is nothing more than a “cursory review” of the record required under example (B), since the seven new dependent claims added are all very clearly supported at the portions of the specification very succinctly and pointed out in the remarks of the Amendment of February 28th. Finally, there is no basis to assert that there would be any “materially added work on the part of the USPTO” under example (C) since nothing more than a simple, cursory review of claims 4-10 and the support for these claims at pages 7, 12 and 13 (i.e. three pages of the specification) is needed to confirm that these claims are appropriate.

In fact, the Amendment filed February 28th falls squarely in the exception of “continued prosecution” stated at MPEP 714.16 in that this Amendment submitted claims “all of the form dependent of claims” without any issues arising in connection with new matter, sufficiency of disclosure, or undue multiplicity of claims whatsoever.

Consequently, it is clear from a review of MPEP 714.16 that the Amendment filed February 28th was entirely appropriate and should be entered of record after the cursory review by the Patent Examiner. It is also noted that the Notice of Allowance was the first Office Action, such that applicants did not have a chance to present the dependent claims 4-10 at an earlier stage in the prosecution, other than submitting these claims with the original application, after having a chance to review the position of the Patent Examiner.

Requested Entry of Amendment

First, it is requested that the Amendment filed February 28th be entered of record such that the patent granting upon the present application includes these dependent claims. If this is not possible because of time pressure constraint due to the patent publication schedule, then it is alternatively that this Petition be granted so that Applicants are entitled to file a Certificate of Correction to add claims 4-10. It would be completely unfair for applicants to have to file a Re-issue Application if the merits of the present Petition are accepted.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

No Petition fee is due, however, if necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: December 23, 2005

Respectfully submitted,

By 

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